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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,281	07/24/2003	Norman Milstein	U 0113 NHG/VEPT	1867

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COGNIS CORPORATION  
PATENT DEPARTMENT  
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EXAMINER

SOLOLA, TAOFIQ A

ART UNIT PAPER NUMBER

1626

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/626,281

Applicant(s)

MILSTEIN, NORMAN

Examiner

Taofiq A. Solola

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-15, 17-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-15, 17-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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Claims 1-15, 17-40 are pending in this application.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-15, 17-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 33-35 are written in functional language and therefore, broader than the enabling disclosure. Therefore, claims 1-15, 17-40 are indefinite. For example, claim 1 recites "providing" and "purifying" in steps (a) and (b). The claims must recite how one of ordinary skill in the art would perform the "providing", "purifying" and "separating" (claim 34). The claims must recite the reagents, the reaction times, pH, and reaction conditions that are involve in the steps. Applicant may not claim all processes of "providing", "purifying" and "separating" that are applicable in the instant invention, known and yet to be developed. Applicant must claim only the processes of "providing"; "purifying" and "separating" that embody applicant's invention. If the provided compounds are starting material they should be so indicated as in claim 34 step (a). The "reducing agent" in claim 35 is a critical element of the step and therefore, must be identified.

A claim must stand alone to define the inventions, and incorporation into the claims by reference to the specification or an external source is not permitted. *Ex parte Fressola*, 27 USPQ 2d 1608, BdPatApp & Inter. (1993). In patent examination, it is essential for claims to be precise, clear, correct, and unambiguous. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989).

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Claim 34 is rejected for being a substantial duplicate of claim 1. Under US patent practice substantial duplicate claims cannot be in the same application. By deleting claim 34 the rejection would be overcome.

Applicant's arguments filed 5/2/05 have been fully considered but they are not persuasive. Applicant contends that the functional language of the claims is from the specification, that process claims are inherently functional and that claims are not to recite details of the invention but only the metes and bounds. This is not persuasive because copying a non-enable specification does not change anything. Yes, claims are inherently functional but "how" a process claim is performed set it apart from similar processes, and is required of process claims under US patent law. See *Ex parte Fressola, supra*. The instant claims set forth "what" is done not "how" it is done.

Applicant also contends the Examiner is judging the critical elements of the claims before applying prior arts. This is not persuasive because, according to the MPEP critical elements are those elements without which a process claim cannot be performed, and therefore must be disclosed. Critical elements of similar process claims may not always be the same.

Applicant further argues that while claim 1 starts with a protected tocopherol claim 34 starts with a tocopherol, and therefore the claims are different. This is not persuasive because tocopherol in claim 34 is protected in step a, and the protected tocopherol in claim 1 inherently starts with tocopherol as in claim 34. Steps a and b in claim 34 together is a substantial duplicate of step a in claim 1 because the claims fail to recite "how" the steps are performed.

Applicant should be notice that under US patent practice patentability of a process claim is determined by "how" the process is performed, and any patent arising from the instant application would be subject to invalidation by US courts.

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

#### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD, JD, whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

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**TAOFIQ SOLOLA**  
**PRIMARY EXAMINER**  
Group 1626

June 1, 2005